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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,186	08/31/2001	Gino W. Kennedy	1750.007	4245
21917	7590	11/14/2003	EXAMINER	
MCHALE & SLAVIN, P.A. 2855 PGA BLVD PALM BEACH GARDENS, FL 33410			GONZALEZ, JULIO C	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/945,186

Applicant(s)

KENNEDY, GINO W.

Examiner

Julio C. Gonzalez

Art Unit

2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 8, 10-17, 19, 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 4-6, 9, 18 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 10-13, 14, 16, 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellum et al in view of Barnhardt et al and Kennedy.

Mellum et al discloses an apparatus for large vehicles being used as securement having a generator 23, an enclosure 20 having vertical side walls, a top parallel to the bottom (see figure 2A), a radiator 28, fan 32 and the enclosure has a wall that may be perforated (see intake 34).

However, Mellum et al does not disclose placing or using the enclosure as a step.

On the other hand, Barnhardt et al discloses for the purpose of minimizing interference with air currents thus reducing air drag, an enclosure 10 being used in large vehicles, which is used as step (see figures 1, 3, 4 and 5). Moreover, the enclosure has vertical walls that are two piece construction (see figure 4).

However, neither Mellum et al nor Barnhardt et al disclose explicitly having a thin vertical bracket between a generator and an engine.

On the other hand, Kennedy discloses for the purpose of reducing the space needed for auxiliary generators and reducing unwanted vibrations, a generator 24, a diesel engine 12 and having a bracket 28 between the generator and the engine (see figure 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design an apparatus having a frame as disclosed by Mellum et al and to modify the invention by using the enclosure as a step for the purpose of minimizing interference with air currents thus reducing air drag as disclosed by Barnhardt et al and to place the generator and engine together by using a bracket for the purpose of reducing the space needed for auxiliary generators and reducing unwanted vibrations as disclosed by Kennedy.

3. Claims 7, 8 and 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellum et al, Barnhardt et al and Kennedy as applied to claims 1 and 14 above, and further in view of Mullican.

The combined apparatus discloses all of the elements above. However, the combined apparatus does not disclose explicitly having the enclosure having vertical walls being hinged to the top.

On the other hand, Mullican discloses for the purpose of providing an anti-theft container, an enclosure having vertical walls height to the top (see figures 5, 6). Moreover, the container can be clamp to frames (see figure 1, 8).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to design the combined apparatus as disclosed above and to modify the invention by using a container with vertical walls hinged to the top for the purpose of providing an anti-theft container as disclosed by Mullican.

4. Claims 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mellum et al, Barnhardt et al and Kennedy as applied to claims 1 and 14 above.

The combined apparatus discloses all of the elements above. However, the combined apparatus does not disclose explicitly the inches height of the walls and perforations.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use such inch dimension values, since it has been held that discovering the optimum value of result effective variable involves only routine skill in the art. *In re Boesch*, 617 F. 2d 272, 205 USPQ 215 (CCPA 1980).

Response to Arguments

5. Applicant's arguments filed 09/10/03 have been fully considered but they are not persuasive.

Mellum et al discloses having an engine/generator inside a container 20 (see figures 1 and 2A) for a large truck. Although it is well in the art to use container or placing them to be use as steps for large trucks, Barnhardt et al discloses using a container 10 as a step for a large truck (see figure 1). The references are well in the field of expertise of anyone with ordinary skill in the art.

Moreover, the Merriam-Webster's Collegiate Dictionary defines "remotely" *as being separated by an interval or space greater than usual*. The claims (e.g. claim 3) disclose that the engine has a remotely mounted radiator and associated fan, but the claims do not define how "remote" these radiator and fan are located. Mellum et al discloses an engine 22 having a remote radiator 28 and fan 32, which are located at a distance (remote) from the engine (see figure 4A).

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge

which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mellum et al, Bernhardt et al deal directly with improvements for large trucks and how to use auxiliary engines for assisting large trucks. Kennedy discloses using an auxiliary engine. Anyone with ordinary skill in the art would be able to encompass such auxiliary engine and use it in many fields, one of them, being in large trucks.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., removing the radiator from the enclosure to allow a more compact enclosure) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Allowable Subject Matter

9. Claims 4, 5, 6, 9, 18 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

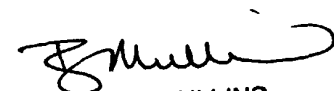
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julio C. Gonzalez whose telephone number is (703) 305-1563. The examiner can normally be reached on M-F (8AM-5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor Ramirez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Jcg

November 5, 2003


BURTON S. MULLINS
PRIMARY EXAMINER